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OFFICE OF PETITIONS

In re Application of :
Steinberg, Sherrer, Duartartas, and:
Schinazi : DECISION REFUSING STATUS
Application No. 10/037,971 : UNDER 37 CFR 1.47(a)
Filed: 24 October, 2001 :
Atty Docket No. ACT141P (11671003) :

This is in response to the petition filed under 37 CFR 1.47(a) on 26 August, 2002.

The petition is **DISMISSED**.

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor.

FAILURE TO RESPOND WILL RESULT IN ABANDONMENT OF THE APPLICATION.
Extensions of time may be obtained in accordance with 37 CFR 1.136(a).

The above-identified issue application was filed on 24 October, 2001, without an executed oath or declaration. Accordingly, on 19 March, 2002, Initial Patent Examination Division mailed a Notice to File Missing Parts of Nonprovisional Application, requiring an executed oath or declaration and a surcharge for its late filing. In response, on 26 August, 2002 (certificate of mailing date 19 August, 2002), petitioners filed a three (3) month extension of time, accompanied by the present petition and authorization to charge the petition fee and late-filing surcharge and a declaration naming Dan A. Steinberg, David W.

Sherrer, Mindaugas F. Duartatas, and Robert G. Schinazi as joint inventors and signed by joint inventors Sherrer and Duartatas on behalf of themselves and joint inventors Steinberg and Schinazi.

Petitioners state that joint inventor Sherrer asked joint inventor Steinberg to sign the declaration, but joint inventor Steinberg refused to sign the declaration. Additionally, petitioners state that joint inventor Schinazi cannot be reached.

A grantable petition under 37 CFR 1.47(a) requires:

- (1) proof that the non-signing inventor cannot be reached or located, notwithstanding diligent effort, or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings);
- (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116;
- (3) the petition fee;
- (4) a surcharge of \$130 or \$65 (small entity) if the petition and/or declaration is not filed at the time of filing the application, and
- (5) a statement of the last known address of the non-signing inventor.

The petition lacks item (1). Petitioners have not shown proof that a copy of the application (specification including claims, drawings, if any, and the Declaration) was sent or given to the non-signing inventors for review.¹ Petitioners should provide a copy of the cover letter transmitting the application papers to the non-signing inventors or details given in an affidavit or declaration of facts by a person having first-hand knowledge of the details.

Likewise, before a *bona fide* refusal to sign can be alleged, petitioners must provide proof that the inventors have refused to sign the declaration.² If there is a written refusal, petitioners should submit a copy of that written refusal with any renewed petition. If the refusal was made orally to a person, then that person must provide details of the refusal in an affidavit or declaration of facts.

If application papers sent to one or more of the inventors at

¹MPEP 409.03(d).

²Id.

their last known addresses are returned as undeliverable, petitioners may show proof that diligent efforts have been made to locate the non-signing inventor(s) by providing a copy of an envelope showing that a letter sent to the last known address of the non-signing inventor was returned as undeliverable by the post office. Details of the efforts made to locate the non-signing inventor should be set forth in an affidavit or declaration of facts by a person having first-hand knowledge of the details.

Additionally, if an inventor(s) cannot be reached at his or her last known address, petitioners must provide details, in an affidavit or declaration of facts by a person with first hand knowledge of the details, of the efforts, such as Internet, e-mail, or telephone directory searches, which have been undertaken to locate that inventor, send or give a copy of the application papers to him or her, and request that he or she sign and return the declaration. If repeated attempts to contact an inventor(s) by telephone, mail, and e-mail, are unsuccessful, petitioners will have established that an inventor(s) cannot be found despite diligent efforts.

It is also noted that if a more recent last known address is found for joint inventor Schinazi, that address should be provided with any renewed petition.

Counsel's deposit account, No. 50-0369, has been charged the \$130.00 fee for consideration of the petition under 37 CFR 1.47(a).

The correspondence address has been changed as indicated in the declaration and power of attorney filed on 26 August, 2002.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Assistant Commissioner for Patents
Box DAC
Washington, D.C. 20231

By FAX: (703) 308-6916
Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite 3C23
2201 S. Clark Place
Arlington, VA

Telephone inquiries related to this decision should be directed to the undersigned at 703-308-6918.



Douglas I. Wood
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for Patent Examination Policy